

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Claims 1-52 are pending. Claims 1-52 stand rejected.

Claims 1, 19, 31, 38, 39, 43, 45-48, and 50 have been amended. No claims have been canceled. No claims have been added. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. Applicant submits that the amendments do not add new matter.

Applicant reserves all rights with respect to the applicability of the Doctrine of Equivalents.

Claims 1, 9-10, 12-15, 19, 24-25, 27-31, 33-34, 37-38, 41, 44 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,490,217 to Wang (“Wang”).

Amended claim 1 reads, in part, as follows: “adding one or more other media objects to the first collection of media objects that is stored at a remote network location, wherein the first collection of media objects has been identified by the scanning the first sheet to create a second collection of media objects at the remote network location, the second collection of media objects including one or more second groups of electronic documents; and re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, wherein the re-marking the first sheet is performed after adding one or more other media objects to the first collection of media objects at the remote location.” (emphasis added).

Wang discloses creating a patient medical progress chart containing a machine-readable code. More specifically, Wang discloses the following:

After the machine readable image code containing form 22 is created the user thereof (i.e., a doctor) can record information, in typed form or even handwritten, thereon which subsequently may be rescanned by the system of the present invention which system will update the computer file on the system and modify the machine readable image code 16 to reflect the addition of new information to that patient's file. When a patient visits a doctor's office or a hospital, a machine readable image code containing medical ID issued to the patient will be scanned, then the present invention system will automatically retrieve the patient's file and display and/or print same.

(Wang, col. 5, lines 44-56)(emphasis added)

Thus, Wang merely discloses updating the computer file on the system. In contrast, amended claim 1 refers to adding one or more other media objects to the first collection of media objects that is stored at a remote network location to create a second collection of media objects at the remote network location. Furthermore, Wang merely discloses modifying the machine readable image code to reflect the addition of new information to that patient's file. In contrast, amended claim 1 refers to re-marking the sheet after adding one or more other media objects to the first collection of media objects at the remote location. Wang fails to disclose, teach, or suggest adding one or more other media objects to the first collection of media objects that is stored at a remote network location to create a second collection of media objects at the remote network location, and re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, wherein the re-marking the first sheet is performed after adding one or more other media objects to the first collection of media objects at the remote location, as recited in amended claim 1.

Therefore, applicant respectfully submits that claim 1, as amended, is not obvious under 35 U.S.C. §103(a) over Wang.

Given that claims 9-10, 12-15, 19, 24-25, 27-30, 31, 33-34, 37-38, 41, and 44 contain some limitations that are similar to those limitations set forth above, applicant respectfully submits that claims 9-10, 12-15, 19, 24-25, 27-30, 31, 33-34, 37-38, 41, and 44 are not obvious under 35 U.S.C. §103(a) over Wang.

The Examiner has rejected claim 46 over U.S. Patent Application Publication US 2002/0052888 to Sellen (“Sellen”).

Amended claim 46 read, in part, as follows: “determining whether the non-electronic medium is erasable so that the content in the non-electronic form is removable directly from the non-electronic document based on the first scanned data and the second scanned data.” (emphasis added).

Sellen discloses comparing the scanned document (data) with the stored document (data) (paragraph [0036]). In contrast, amended claim 46 refers to the first scanned data and the second scanned data. Furthermore, Sellen fails to disclose determining whether the non-electronic medium is erasable so that the content in the non-electronic form is removable directly from the non-electronic document based on the first scanned data and the second scanned data, as recited in amended claim 46.

Therefore, applicant respectfully submits that amended claim 46 is not obvious over Sellen.

Claims 2-4, 6-7, 20-22, 32, 36, 39-40, 43, 45, 48, and 50-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of U.S. Patent No. 6,432,518 to Torii et al. (“Torii”).

As set forth above, Wang fails to disclose adding one or more other media objects to the first collection of media objects that is stored at a remote network location to create a second collection of media objects at the remote network location, and re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, wherein the re-marking the first sheet is performed after adding one or more other media objects to the first collection of media objects at the remote location, as recited in amended claim 1.

Torii, in contrast, discloses an erasable recording material.

Furthermore, even if Torii and Wang were combined, such a combination would still lack adding one or more other media objects to the first collection of media objects that is stored at a remote network location to create a second collection of media objects at the remote network location, and re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, wherein the re-marking the first sheet is performed after adding one or more other media objects to the first collection of media objects at the remote location, as recited in amended claim 1.

Given that claims 2-4, 6-7, 20-22, 32, 36, 39-40, 43, 45, 48, and 50-52 contain the some limitations that are similar to those limitations discussed above, applicant respectfully submits

that claims 2-4, 6-7, 20-22, 32, 36, 39-40, 43, 45, 48, and 50-52 are not obvious under 35 U.S.C. §103(a) over Wang in view of Torii.

Claim 42 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Torii and further in view of U.S. Patent No. 6,373,575 to Takayama (“Takayama”).

As set forth above, even if Wang and Torri were combined, such a combination would still lack a processing unit to modify the first collection of media objects by adding one or more pages of the one or more other media objects to the first collection of media objects that is stored at a remote network location to create a second collection of media objects at the remote network location, wherein the first collection of media objects has been identified by the scanning a first identifier on the first sheet using the scanner configured to scan the images; and a marking unit to re-mark the sheet that includes a printer to print a new identifier and new graphic content having one or more second thumbnails representing the second collection of media objects onto the sheet in a non-electronic form, wherein the re-marked first sheet including the new identifier and the new graphic content in the non-electronic form provides access to the second collection of the media objects, wherein the marking unit is configured to re-mark the first sheet after adding one or more other media objects to the first collection of media objects at the remote location, as recited in amended claim 39.

Takayama, in contrast, discloses a paper classification apparatus.

Furthermore, even if Wang, Torii, and Takayama were combined, such a combination would still lack a processing unit to modify the first collection of media objects by adding one or more pages of the one or more other media objects to the first collection of media objects that is stored at a remote network location to create a second collection of media objects at the remote network location, wherein the first collection of media objects has been identified by the scanning a first identifier on the first sheet using the scanner configured to scan the images; a

marking unit to re-mark the sheet that includes a printer to print a new identifier and new graphic content having one or more second thumbnails representing the second collection of media objects onto the sheet in a non-electronic form, wherein the re-marked first sheet including the new identifier and the new graphic content in the non-electronic form provides access to the second collection of the media objects, wherein the marking unit is configured to re-mark the first sheet after adding one or more other media objects to the first collection of media objects at the remote location, as recited in amended claim 39.

Given that claim 42 depends from amended claim 39, and adds additional limitations, applicant respectfully submits that claim 42, as amended, is not obvious under 35 U.S.C. §103(a) over Wang in view of Torii and further in view of Takayama.

Claims 5, 8, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Torii and in further view of U.S. Patent No. 5,764,368 to Shibaki (“Shibaki”).

Shibaki, in contrast, discloses an image processing apparatus using retrieval sheets capable of recording additional retrieval information.

Furthermore, even if Wang, Torii, and Shibaki were combined, such a combination would still lack adding one or more other media objects to the first collection of media objects that is stored at a remote network location to create a second collection of media objects at the remote network location, and re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, wherein the re-marking the first sheet is performed after adding one or more other

media objects to the first collection of media objects at the remote location, as recited in amended claim 1.

Given that claims 5, 8 and 23 contain some limitations that are similar to those limitations set forth above, applicant respectfully submits that claims 5, 8 and 23 are not obvious under 35 U.S.C. §103(a) over Wang in view of Torii and in further view of Shibaki.

Claims 11, 26, and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of U.S. Patent No. 3,713,148 to Cardullo et al. (“Cardullo”).

Cardullo, in contrast, discloses a transponder.

Furthermore, even if Wang, Torii, and Cardullo were combined, such a combination would still lack adding one or more other media objects to the first collection of media objects that is stored at a remote network location to create a second collection of media objects at the remote network location, and re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, wherein the re-marking the first sheet is performed after adding one or more other media objects to the first collection of media objects at the remote location, as recited in amended claim 1.

Given that claims 11, 26, and 35 contain some limitations that are similar to those limitations discussed above, applicant respectfully submits that claims 11, 26, and 35 are not obvious under 35 U.S.C. §103(a) over Wang in view of Cardullo.

Claims 16-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of U.S. Patent No. 6,260,063 to Ludtke et al. (“Ludtke”).

Ludke, in contrast, discloses using object lists and object entries.

Furthermore, even if Wang, Torii, and Ludke were combined, such a combination would still lack adding one or more other media objects to the first collection of media objects that is stored at a remote network location to create a second collection of media objects at the remote network location, and re-marking the first sheet that includes printing a second graphical content having one or more second thumbnails representing the second collection of media objects onto the first sheet using a printer, such that the second graphical content is presented on the first sheet in a non-electronic form, wherein the re-marked first sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, wherein the re-marking the first sheet is performed after adding one or more other media objects to the first collection of media objects at the remote location, as recited in amended claim 1.

Given that claims 16-18 depend from amended claim 1, and add additional limitations, applicants respectfully submit that claims 16-18 are not obvious under 35 U.S.C. §103(a) over Wang in view of Ludtke.

Claim 47 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of U.S. Publication No. 2002/0064113 to Geeslin (“Geeslin”).

Amended claim 47 includes detecting a writable mark in a scanned image of a re-writable paper, wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium, wherein the writable mark in the scanned image indicates that the re-writable paper is non-rewritable.” (emphasis added).

The Examiner acknowledged that “Wang does [not] explicitly disclose marking the sheet with a machine-readable indicator that indicates that the sheet is not to be erased.” (Office Action, p. 12). Accordingly, Wang fails to disclose detecting a writable mark in a scanned image

of a re-writable paper, wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium, wherein the writable mark in the scanned image indicates that the re-writable paper is non-rewritable, as recited in amended claim 47.

Geeslin, in contrast, discloses a protection state byte for the optical disc media. (paragraph [0032]). In contrast, amended claim 47 refers to detecting a writable mark in a scanned image of a re-writable paper, wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium, wherein the writable mark in the scanned image indicates that the re-writable paper is non-rewritable.

Torii, in contrast, discloses an erasable recording material. Torii fails to disclose detecting a writable mark in a scanned image of a re-writable paper, wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium, wherein the writable mark in the scanned image indicates that the re-writable paper is non-rewritable, as recited in amended claim 47.

Furthermore, even if Torii, Wang, and Geeslin were combined, such a combination would still lack detecting a writable mark in a scanned image of a re-writable paper, wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form, wherein the re-writable paper is a non-electronic medium, wherein the writable mark in the scanned image indicates that the re-writable paper is non-rewritable, as recited in amended claim 47.

Therefore, applicant respectfully submits that claim 47, as amended, is not obvious under 35 U.S.C. §103(a) over Wang in view of Geeslin.

Claim 49 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wang in view of Torii and in further view of Sellen.

As set forth above, even if Wang and Torii were combined, such a combination would still lack adding one or more other media objects to the first collection of media objects that is stored at a remote network location, wherein the first collection of media objects has been identified by the scanned image, to create a second collection of media objects at the remote network location, the second collection of media objects including one or more second groups of electronic documents; and re-marking the sheet that includes printing a second graphical content having one or more second thumbnails to represent the second collection, such that the second graphical content is presented on the sheet in a non-electronic form using a printer, wherein the re-marked sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, wherein the re-marking the sheet is performed after adding one or more other media objects to the first collection of media objects at the remote location, as recited in amended claim 48.

Sellen, in contrast, discloses an electronic record storage.

Furthermore, even if Sellen, Torii, and Wang were combined, such a combination would still lack adding one or more other media objects to the first collection of media objects that is stored at a remote network location, wherein the first collection of media objects has been identified by the scanned image, to create a second collection of media objects at the remote network location, the second collection of media objects including one or more second groups of electronic documents; and re-marking the sheet that includes printing a second graphical content having one or more second thumbnails to represent the second collection, such that the second graphical content is presented on the sheet in a non-electronic form using a printer, wherein the re-marked sheet including the second graphical content in the non-electronic form provides access to the second collection of the media objects, wherein the re-marking the sheet is

performed after adding one or more other media objects to the first collection of media objects at the remote location, as recited in amended claim 48.

Given that claim 49 depends from amended claim 48 and adds additional limitations, applicant respectfully submits that claim 49 is not obvious under 35 U.S.C. §103(a) over Wang in view of Torii and further in view of Sellen.

It is respectfully submitted that in view of the amendments and arguments set forth herein, the applicable rejections and objections have been overcome. If the Examiner believes a telephone conference would expedite in the prosecution of the present application, the Examiner is invited to call the undersigned at (408) 720-8300.

If there are any additional charges, please charge Deposit Account No. 022666.

Respectfully submitted,
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Date: January 28, 2011

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